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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,054	08/14/2001	Charles Baker	53403-261768 LB-007	1180

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EXAMINER

UBILES, MARIE C

ART UNIT PAPER NUMBER

2642

DATE MAILED: 08/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,054

Applicant(s)

BAKER, CHARLES

Examiner

Marie C. Ubiles

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on June 17, 2004 has been entered. Claim 1 has been amended. No claims have been cancelled. No claims have been added. Claims 1-22 are still pending in this application, with claims 1, 6, 10, 15 and 19 being independent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine (US 6,157,640) in view of MacMahan et al. (US 5,402,477).

As for claims 1-2, Valentine discloses an apparatus comprising, a call state monitor (or *control node 200*) configured to determine a call state of a device (or *smart terminal 160*)(See Col. 8, lines 7-10); and a telephony wizard (or *application module 100*), coupled to the call state monitor, configured to identify a list of telephony documentation (or *call wait, forward-to-number, record a message*) available during the call state (as read into the user providing instruction regarding call treatment for that particular call)(See Col. 8, lines 10-40).

While it is obvious that Valentine provide the user with different choices for call treatment (as read on the use of a CAW module 40, CFB module 30, or LC 80); it can be seen that Valentine lacks the limitation specifying "...and configured to present the list to the user."

MacMahan et al. teaches a method and system for updating telephone special services (or *telephony documentation*) (e.g. camp-on, call forwarding, transfer, conference calls, call waiting and call pick-up)(See Col. 7, lines 10-62) and after compiling a list of services available for that telephone, displaying such information to user (See Col. 9, lines 10-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Valentine's system by updating a list of special services and providing such list to a user, as taught by MacMahan et al.; and thus in this manner display a representation of each supported service to the user.

As for claims 3, 8 and 14, the Examiner takes Official Notice that system and methods exist in the art to perform presenting a list of services (or telephony documentation) to a user based on "idle" and "dialing" states. In regards, to presenting a list of telephony documents to the user while the device is in "idle" state, may read for example, on the caller being offer call completion of a number recorded on a digital answering machine (See 6,493,443. Col. 1, lines 24-30). The "dialing" state reads into an 411 automatic operator offering an user to complete a call based on a fixed fee.

Claims 4-7, 9-13, 15-22 are rejected for the same reasons as claims 1-2. The limitation specifying an "active call state" may be read on Valentine's user *being already*

in a speech connection with a first call (See Col. 8, lines 7-10). The limitations specifying "including a star code for an available feature" (or *60) and "dialing the star code when the available feature is selected" are well know in the art (See, for example, the teachings of McMahan et al. in respect to those features in Col. 9, lines 19-20).

Response to Arguments

4. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Marie C. Ubiles
August 13, 2004.


JACK CHIANG
PRIMARY EXAMINER